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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,156	03/31/2004	Jagmohan Singh	Q80880	4448
23373 7590 03/23/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER MARVICH, MARIA	
			ART UNIT	PAPER NUMBER
			1633	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		03/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/813,156

Applicant(s)

SINGH ET AL.

Examiner

Maria B. Marvich, PhD

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, drawn to nmt-185 (SEQ ID NO:1), classified in class 536, subclass 24.1.
 - II. Claims 1-24, drawn to nmt-146 (SEQ ID NO:2), classified in class 536, subclass 24.1.
 - III. Claims 25-62, drawn to a method of isolating a promoter and preparing vectors with the nmt-185 promoter, classified in class 435, subclass 6.
 - IV. Claims 25-62, drawn to a method of isolating a promoter and preparing vectors with the nmt-146 promoter, classified in class 435, subclass 6.

The inventions are distinct each from the other because of the following reasons:

Inventions I and II are directed to related products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). Both Group I and II are drawn to promoters that are temperature regulated. However, the promoters are structurally distinct as evidenced by their distinct structural sequences and functionally these sequences, which mediate transcription at 40 and 80 base pairs upstream of the nm1 promoter, have distinct functions endogenously. Hence, the related

Art Unit: 1633

promoters have different design and mode of operation. For these reasons the Inventions of I-II are patentably distinct.

Furthermore, the distinct steps and products require separate and distinct searches. A search for art pertaining to nmt-185 is not overlapping with a search for art for nmt-146. As well as distinct art searches, each promoter would be examined in sequence databases using their distinct sequences and functionally these sequences mediate transcription at 40 and 80 base pairs upstream of the nm1 promoter. As such, it would be burdensome to search the inventions of Groups I and II together.

Inventions III and IV are directed to related processes. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). Both Group III and IV are drawn to processes for isolation of promoters that are temperature regulated. However, each method is directed to isolation of distinct promoters using distinct sequences as probes. The methods are not capable of use together and have distinct effect in isolating distinct promoters as set forth above. For these reasons the Inventions of III and IV are patentably distinct.

Furthermore, the distinct steps and products require separate and distinct searches. A search for art pertaining to nmt-185 is not overlapping with a search for art for nmt-146. As well as distinct art searches, each promoter would be examined in sequence databases using their distinct sequences. A search for art for a method of isolating nmt-185 would not thus be

Art Unit: 1633

overlapping with a search for art pertaining to nmt-146. As such, it would be burdensome to search the inventions of Groups III and IV together.

Inventions I and III-IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the methods of Group III-IV need not necessarily be used to generate the promoter of Group I as the promoters of Group II can be isolated by the same steps. As well, the promoters can be made synthetically.

Searching the inventions of either Groups I and Group III-IV together would impose serious search burden. The inventions of Groups I and III-IV have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the promoters and the method of isolating the promoter are not coextensive. Prior art, which teaches a promoter, would not necessarily be applicable to the method of making the promoter. Moreover, even if the product were known, the method of making the product may be novel and unobvious in view of the preamble or active steps.

Inventions II and III-IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the methods of Group III-IV need not necessarily be used to generate the promoter

Art Unit: 1633

of Group II as the promoters of Group I can be isolated by the same steps. As well, the promoters can be made synthetically.

Searching the inventions of either Groups II and Group III-IV together would impose serious search burden. The inventions of Groups II and III-IV have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the promoters and the method of isolating the promoter are not coextensive. Prior art, which teaches a promoter, would not necessarily be applicable to the method of making the promoter. Moreover, even if the product were known, the method of making the product may be novel and unobvious in view of the preamble or active steps.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for each group is not required for the other groups because each group requires a different non-patent literature search due to each group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provision of MPEP 821.04. Process claims that depend from or otherwise include all the limitations of the patentable produce will be entered as a matter of right if the amendment is presented prior to final rejection or

Art Unit: 1633

allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendment submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirements for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 USC 101, 101, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claim in light of *In re Ochiai*, *In re Brouwer* and 35 USC 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 USC 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1633

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B. Marvich, PhD whose telephone number is (571)-272-0774. The examiner can normally be reached on M-F (7:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach, PhD can be reached on (571)-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Maria B Marvich, PhD

Application/Control Number: 10/813,156

Page 8

Art Unit: 1633

Examiner
Art Unit 1633